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In re Application of VARDI et al
U.S. Application No.: 09/600,348
Int. Application No.: PCT/US99/00835
Int. Filing Date: 13 January 1999
Priority Date: 14 January 1998
Attorney Docket No.: 19601-000120US
For: EXTENDIBLE STENT APPARATUS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under §1.47(a) 'Filing When an Inventor Cannot be Reached'" filed 16 January 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 13 January 1999, applicants filed international application PCT/US99/00835, which claimed priority of an earlier United States application filed 14 January 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 14 July 2000.

On 14 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 10 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 16 January 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that inventor Eric Elam cannot be reached after diligent effort.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by three of the joint inventors on their own behalf and on behalf of the nonsigning inventor Elam.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In the present case, applicants have provided an affidavit from Rosalinda Rafael, who states in the affidavit that she attempted to contact Elam by mail on 23 October 2000, by telephone in January 2001, and by electronic mail (see Rafael's affidavit, page 2). Rafael also states that she made inquiries to the three other joint inventors, Elam's former co-workers, and other associates of Elam. While Rafael's attempts demonstrate a diligent effort to locate Elam, applicant is required to provide additional documentary evidence concerning the 23 October 2000 letter. Specifically, applicant should more specifically detail the contents of the 23 October 2000 correspondence and provide a copy of the cover letter of instructions. Such additional evidence should indicate that Elam was requested to respond to the 23 October 2000 communication in a timely manner.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

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CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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